

Amdt. dated August 17, 2005
Reply to Office action of May 17, 2005

Serial No. 09/658,078
Docket No. ROC920000078US1
Firm No. 0021.0010

REMARKS/ARGUMENTS

Claims 1-11, 15-25, and 29-39 have been elected.

The applicant has studied the Office Action dated May 17, 2005 and believes the application is in condition for allowance. Reconsideration and reexamination are respectfully requested.

In the above listing of claims, the Roman numeral (i) of claims 1, 15, 17, 26 and 29 is set forth as (i), that is, a small case i. It is noted that in prior claim listings, the Roman numeral (i) has sometimes been set forth as (I), that is, a capitalized I, as a result of automated text substitution by a word processing program rather than any intentional claim amendment. However, in the claims as originally filed, the roman numeral (i) is set forth as (i), that is, a small case i. Accordingly, it is believed that the above claim listing is correct.

Claims 1-6, 8-11, 15-20, 22-25, 29-34 and 36-39 have been rejected as being unpatentable (35 U.S.C. 103(a)) over Courter et al. (hereinafter the Courter reference) in view of Pandit (US 5859636). Claims 7, 21 and 35 have been rejected as being unpatentable (35 U.S.C. 103(a)) over Courter et al. (hereinafter the Courter reference) in view of Pandit (US 5859636) and further in view of Nielson (US 5907680). These rejections are respectfully traversed.

Claim 1 requires, *inter alia*, " ... scanning and parsing words in the text; for each set of one or more scanned and parsed words, determining whether one or more words form a scanned contact phrase providing information to identify or address a person or entity ..." The Examiner has cited no teaching or suggestion in the Courter reference of a method comprising "scanning and parsing words in the text; for each set of one or more scanned and parsed words, determining whether one or more words form a scanned contact phrase providing information to identify or address a person or entity " as required by claim 1. Indeed, the Examiner concedes that the Courter reference does not "explicitly teach scanning ..., etc."

The Examiner cites the Pandit reference as describing a system capable of recognizing "such classes of text as Uniform Resource Locators, nouns, verbs, names, street addresses, etc."

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However, the Examiner has cited no portion of the Pandit reference which in any manner teaches or suggests:

“upon determining that one or more words form a scanned contact phrase, performing: (i) accessing contact information including contact phrases; and (ii) searching the contact information to determine if the scanned contact phrase matches contact phrases in the searched contact information; and upon determining that one or more words do not form a scanned contact phrase, performing said scanned contact phrase determining with respect to other words of said text” as required by claim 1.

Instead, the Examiner's citations to the Pandit reference merely describe providing a pull-down menu when an email address has been accented. Included on the email pull down menu, is an “EMAIL template and transmitting program, preferably automatically addressed with the accented address recognized in the text.” It is apparently the Examiner's position that the deficiencies of the Pandit reference are met by the Examiner's citations to the Courter reference. The applicants strongly disagree.

The Examiner's citations to the Pandit reference describe providing a user the opportunity to invoke an email program when an email address is recognized. It is apparently the Examiner's position that the email program which would be invoked would be the Outlook program of the Courter reference. However, even if the systems of the Pandit and Courter references were combined in the manner suggested by the Examiner, such a combined system would still lack, for example, the requirement of Claim 1 that “upon determining that one or more words do not form a scanned contact phrase, performing said scanned contact phrase determining with respect to other words of said text.” The Examiner has cited no teaching or suggestion in the Courter reference of a method comprising “upon determining that one or more words do not form a scanned contact phrase, performing said scanned contact phrase determining with respect to other words of said text” as explicitly required by claim 1. Instead, as noted in prior submissions, all text entered by the user into the “E-mail” input field of the Outlook

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Contact form cited by the Examiner appears to be treated by the Outlook program as an e-mail address without any prior determination as such.

The deficiencies of the Examiner's citations to the Courter and Pandit references are not met by the Examiner's citations to the Nielson reference.

Independent claims 15 and 29 may be distinguished in an analogous fashion.

Claims 2-11 depend either directly or indirectly from claim 1; claims 16-25 depend either directly or indirectly from claim 15; and claims 30-39 depend either directly or indirectly from claim 29. Accordingly, the rejection of these claims is improper for the reasons given above. Moreover, these dependent claims include additional limitations, which in combination with the base and intervening claims from which they depend provide still further grounds of patentability over the cited art. For example, dependent claim 2 further provides that in the method of claim 1, the "contact phrases comprise one of a name, phone number, street address, e-mail address, and URL" and the method of claim 1 further comprises "spell checking words determined not to form a scanned contact phrase."

The Examiner has made various comments concerning the anticipation or obviousness of certain features of the present inventions. Applicant respectfully disagrees. Applicant has addressed those comments directly herein above or the Examiner's comments are deemed moot in view of the above response.

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Conclusion

For all the above reasons, Applicant submits that the pending claims 1-11, 15-25 and 29-39 are patentable over the art of record. Applicants have not added any claims. Nonetheless, should any additional fees be required, please charge Deposit Account No. 50-5085.

The attorney of record invites the Examiner to contact him at (310) 553-7977 if the Examiner believes such contact would advance the prosecution of the case.

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Dated: August 17, 2005

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